

REMARKS

Claims 1-14 which are in the application stand rejected under 35 USC 103(a) as being unpatentable over Nehen et al (US 5,634, 211), and further stand rejected under the judicially created doctrine of obviousness type double patenting over Claims 1-9 of US 5,634, 211.

Applicants traverse the rejections because the cited reference does not contain basis for modifying the prior art to the claims with a reasonable expectation of success. More specifically, the cited reference does not provide criteria for selecting the proportions of the components of the claims with a reasonable expectation of success.

The patentable distinction of the claims is discussed more fully hereunder by presenting the basis for the rejections and how they are avoided or overcome.

The 35 USC 103 rejection is based on the grounds that:

"Nehen et al. teach carbonless copy papers which employ microcapsules having walls which comprise the reaction products of polyisocyanates, guanidine compounds such as guanidine carbonate and optionally amines (see column 2, line 39)."

Hence the Examiner contends that the claims are obvious because:

"The experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine the isocyanurate content and the weight % of the walls based on the total weight of the microcapsules) fails to render applicants' claims patentable in the absence of unexpected results."

While the Examiner is correct in characterizing the prior art, it is well settled in the law that the fact the claimed invention falls within the prior art does not necessarily render it obvious, absent some showing in the prior art which would lead the skilled artisan to the claimed invention, In re Vaeck 20USPQ2d 1483 (Fed. Cir. 1991).

In this case, nothing in Nehen et al. suggests the modification of the isocyanurate content. Nothing in Nehen et al. suggest the modification of the percent by weight of the walls. Certainly, nothing in Nehen et al. suggests the modification of the two variables which would have led to the claims. It is well established in the art that a particular variable must first be recognized as a

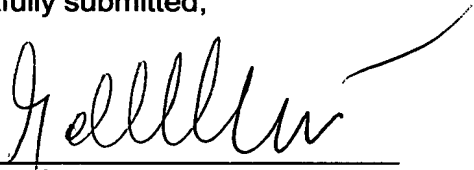
result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable, In re Antonie 195 USPQ 6 (CCPA 1977). Applicants are unaware of such a recognition. It would therefore be helpful to Applicants for the Examiner to provide some evidence or practical reason why such variables would have been recognized as being result effective. To the extent that such a showing is lacking the Examiner would be justified in withdrawing Nehen et al as reference and allowing the claims.

With regard to the double-patenting rejection over Claims 1-9 of Nehen et al, Applicants submit the above arguments equally apply thereto and are adopted therefor.

Net: In view of the foregoing arguments, Applicants submit that the claims in the application are patentably distinct, and, therefore, pray for their allowance.

Respectfully submitted,

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